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Oral Hearing:
December 18, 2001

Paper No. 19
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 1-800 CONTACTS, INC.

Serial No. 75/746,706

Jeffrey A. Handelman and Thomas M. Williams of Brinks,
Hofer, Gilson & Lione for 1-800 CONTACTS, INC.

Ronald McMurrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Walters, Wendel and Drost, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

1-800 CONTACTS, INC. has filed an application to
register the mark 1800CONTACTS¹ for "mail order and
telephone order services in the field of contact lenses
and related products, and electronic retailing services

¹ The mark in the drawing for this application does not have any spaces between the numbers or letters. However, the applicant's name is 1-800 CONTACTS and references by third parties to applicant and/or to its mark often employ spaces and/or dashes (e.g., 1-800-CONTACTS or 1 800 CONTACTS). The examples of use of the mark by applicant in the record generally use colors and shapes to distinguish the components of the mark. When quoting third parties in this opinion, we have merely transcribed the mark as written in the quoted material.

via computer featuring contact lenses and related products."² The application as filed included a claim of acquired distinctiveness, under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f), based on a declaration by applicant's chief financial officer alleging extensive advertising and consumer recognition. In support of its claim of acquired distinctiveness, applicant subsequently submitted additional affidavits and evidence, including a survey.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the term which is the subject of this application is generic and, alternatively, that the term is merely descriptive of applicant's services and applicant has not made an adequate showing of acquired distinctiveness.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, and an oral hearing was held.

Genericness

The Examining Attorney contends that 1800CONTACTS is generic because it "consists of a generic term combined

² Serial No. 75/746,706, in International Class 35, filed July 8, 1999, based on use of the mark in commerce, alleging first use and use in commerce as of July 1995.

with a toll-free telephone area code which has no source indicating significance"; that the category of services involved is telephone ordering services featuring contact lenses; and that the relevant public will clearly understand the term to refer to these services.

Alternatively, the Examining Attorney contends that applicant's showing of acquired distinctiveness is inadequate. However, he does not specify his reasons for this conclusion other than by reiterating his conclusion that the term is generic.³

Applicant contends that 1800CONTACTS is not generic, arguing that the genus of its services is "shop-at-home retail services for contact lenses"; that its mark must be considered as a whole; and that its "evidence in the form of consumer surveys, newspaper articles, and other publications ... establishes that consumers perceive 1800CONTACTS as a mark rather than as a generic term."

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is

whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney and applicant disagree about the significance herein of the Federal Circuit's decision in *In re Dial-A-Mattress Operating Corp.*, 240 F.3rd 1341, 57 USPQ2d 1807 (Fed. Cir. 2001).

The Examining Attorney argues that the case before us may be distinguished from *Dial-A-Mattress* on its facts. The Examining Attorney contends that in this case, the "800 [telephone] prefix is clearly the most famous and widely recognized toll-free area code,"

³ Because it is an alternative argument, an Examining Attorney making a refusal on the ground that a term is generic should also address an

whereas "the more recently introduced and less widely recognized 888" telephone prefix was the subject of the *Dial-A Mattress* case. He made the following additional arguments:

The present case is also distinguishable from *Dial-A-Mattress* because the term *Mattress* combined with the toll-free area code was misspelled in creating the mark. The misspelling of the term produced a mark with an entirely different commercial impression than that created by the mark in this case.

...
... [R]egistration of a mark comprised of a generic toll-free area code and a generic term would preclude competitors from registration of marks comprised of the same generic term and a different toll-free area code. ... Consumers exposed to 1800CONTACTS, 1888CONTACTS, or 1877CONTACTS would never attribute trademark significance to the toll-free exchanges and would be forced to rely upon the generic term.

Applicant argues that the Federal Circuit's *Dial-A-Mattress* decision "abolishes what was, in effect, a *per se* rule against registration of marks that included the '1-800' element and a generic term." Applicant contends that this case falls squarely within the facts and decision of *Dial-A-Mattress*; that the Examining Attorney has applied the traditional two-part test in *Marvin Ginn* to the separate elements of its mark, rather than to the mark as a whole; and that the evidence establishes that

allegation of acquired distinctiveness on its merits.

consumers perceive of 1800CONTACTS as a mark rather than as a generic term.

In *Dial-A-Mattress*, the Court concluded that the Board had erred in finding the term 1-888-M-A-T-R-E-S-S generic for telephone shop-at-home retail services in the field of mattresses; that the term is merely descriptive in connection with the identified services; and that evidence of applicant's prior registrations is sufficient to establish acquired distinctiveness.

The Court stated the following:

Here, there is no dispute that the genus is telephone shop-at-home services for retail mattresses. Nor does Dial-A-Mattress contest the following evidence and legal conclusions offered by the Director: (1) the area code designation (888) in the proposed mark by itself is devoid of source-indicating significance; (2) "mattress" is the legal "equivalent" of the word "mattress"; and (3) the word "mattress" standing alone is generic for retail services in the field of mattresses.

However, the Court found that the Board erred by applying to this case the test established in *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [compound term, SCREENWIPE, formed by the union of two generic terms is generic if the compound term has the same meaning common usage would ascribe to the individual words]. The Court in *Dial-A-Mattress* reasoned that the term 1-888-M-A-T-R-E-S-S is not like a compound word;

rather it is analogous to the phrase involved in *In re American Fertility Society*, 188 F.3rd 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) [genericness determination must be based on the meaning as a whole of the phrase SOCIETY FOR REPRODUCTIVE MEDICINE, not based only on definitions and generic uses of the constituent terms of the mark].

Thus, applying the test established in *American Fertility Society*, the Court concluded that "[t]he Director must produce evidence of the meaning the relevant purchasing public accords the proposed mnemonic mark 'as a whole.'"

In this regard, the Court stated the following:

Analyzing the "1-888-M-A-T-R-E-S-S," mark as a whole, substantial evidence does not support the conclusion that the mark is generic. There is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as "1-888-M-A-T-R-E-S-S." "Telephone shop-at-home mattresses" or "mattresses by phone" would be more apt generic descriptions. Like the title "Fire Chief" for a magazine in the field of fire fighting, a phone number is not literally a genus or class name, but is at most descriptive of the class. Moreover, like the term "cash management account," "1-888-M-A-T-R-E-S-S" does not "immediately and unequivocally" describe the service at issue. (*Citations omitted.*)

Notwithstanding the Examining Attorney's arguments to the contrary, the case before us is legally and factually identical in all relevant aspects to the *Dial-A-Mattress* case. Therefore, having reviewed the evidence

of record, we find that the Examining Attorney has failed to establish that the "phrase" 1800CONTACTS, as a whole, is generic for the identified services. However, as in the *Dial-A-Mattress* case, it is merely descriptive thereof because it immediately conveys the impression that a service relating to contact lenses is available by calling the telephone number.

Acquired Distinctiveness

Having determined that 1800CONTACTS is not generic, we now address the question of whether applicant has established that 1800CONTACTS has acquired distinctiveness.

Relevant to this question, applicant submitted the following evidence:

- Declaration dated June 25, 1999 of Scott Tanner, applicant's chief financial officer, attesting to use of the mark in connection with the services since July 1995; to advertising expenses since first use of "over \$33 million"; to the nature of its national advertising since June 1998; that since June 1998, half of its advertising budget has been spent on television advertising; and to sales totaling "nearly \$100 million."

- Declaration dated January 11, 2001 of R. Joe Zeidner, applicant's general counsel, attesting to the same facts recited in Mr. Tanner's declaration and adding that sales now total nearly \$300 million; and that sales reached nearly \$90 million in 1999 alone.
- Evidence showing use of the mark in advertising and on packaging; and evidence of articles excerpted from the LEXIS/NEXIS database that discuss applicant's business.
- Survey conducted for applicant by Market Facts, Inc. in March-April 2000 (discussed below).
- Survey conducted for applicant by Thomas D. Dupont of D² Research, dated January 2001 (discussed below).

The survey conducted by Market Facts, Inc. consisted of randomized telephone interviews with 1,000 individuals. Survey respondents were asked whether they wear contact lenses; what companies they have seen or heard of that sell contact lenses by mail or on the Internet (unaided recall); whether they had heard of listed companies, including applicant (aided recall); and, if they wear contact lenses and purchased their last pair of contact lenses by mail or Internet, from whom did they make that purchase. Detailed information about the survey results and methodology was not submitted. The summary of the survey results stated that, "among the

representative sample of contact lens wearers, 1-800 Contacts measured 20.8% unaided awareness, 40.2% aided awareness and 61.0% total awareness." While more information concerning the survey methodology and results would have increased the evidentiary value of the survey herein, we find it to be probative of the issue of acquired distinctiveness.

The survey conducted by Dr. Dupont was a "national double blind telephone survey" among 326 men and women, ages 18 and over, who wear contact lenses (the analytical sample, i.e., those who understood the difference between a common name and a brand name, was 301). The stated goal of the survey is "to determine whether consumers perceive '1 800 CONTACTS' as a brand name or as a generic name." The stated result is "that nearly three quarters of respondents (74.4%) perceived that '1 800 CONTACTS' is a brand name, and that only 19.3% thought it is a common name."

Dr. Dupont's report describes the survey, in part, as follows:

Survey respondents were given the following instructions:

In this survey I'm going to ask you about some names and ask you to tell me whether you think they are brand names or common names. For example:

For a business that sells gasoline, SHELL would be a brand name and SERVICE STATION would be a common name.

...

They were then asked the same question for each of seven names. The question for "1 800 CONTACTS," which illustrates the form of the question, was:

For a business that sells CONTACT LENSES, would you say 1 800 CONTACTS is a brand name or a common name?

This survey is clearly directed to our initial question of whether 1800CONTACTS is generic in connection with the identified services. Because we have determined that 1800CONTACTS is not generic, it is not necessary for us to evaluate the effectiveness of this survey for its stated purpose. Further, we find that the survey is not probative of the issue of acquired distinctiveness. It does not address the question of whether relevant consumers are aware of the phrase as an existing trademark for applicant's services in particular.

However, considering the evidence in the record that is probative of acquired distinctiveness, we find that applicant has established that 1800CONTACTS has acquired distinctiveness as applicant's trademark for the identified services. At the time applicant submitted its declaration by Mr. Tanner, applicant's mark had been in use for more than five years; the dollar sales stated in Mr. Tanner's declaration, particularly the recent sales,

are significant; and the advertising figures are significant. Evidence of advertising shows applicant's clear use and promotion of the phrase as a trademark and the Market Facts survey shows consumer awareness. The other evidence of record supports this conclusion.

Decision: The refusal under Section 2(e)(1) of the Act on the ground that the mark is generic is reversed. The refusal under Section 2(e)(1) of the Act on the ground that this merely descriptive mark has not acquired distinctiveness is reversed. The application will be forwarded for publication of the mark for opposition in due course.